

## REMARKS

In response to the November 2, 2004, Restriction Requirement, Applicants elect with traverse the subject matter of Group I, claims 1-10 and 13-16, drawn to a method of identifying a protease. Applicants traverse the restriction of Groups I claims from those of Group II and respectfully request that the Examiner combine these claims into a single group.

The Office Action did not state why or how these two groups were unrelated inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, §808.01). In the instant case, Group I (claims 1-10 and 13-16) is drawn to a method of identifying a protease. Group II (claims 11-12) is drawn to a method of identifying a protease wherein the target protein is caspase-3. Applicants believe Group II is a subset of Group I, and request that claims 1-16 should be treated as a single invention.

The steps of Groups I and II, drawn to a method for identifying a protease which cleaves a substrate sequence, remain the same regardless of the substrate sequence used. Therefore the claimed steps are capable of use together. The claimed steps have the same or similar modes of operation. And the claimed steps have the same functions and the same effects, which is to identify a protease which cleaves a substrate sequence.

Because the methods of the invention are not limited by a particular target protein, Applicants respectfully request that the Examiner combine Groups I and II and examine all of claims 1-16.

Applicants elect the following subspecies, as required on page 4 of the Office Action: (A) N is a positive integer between 1-20; (B) the granzyme B protease scaffold; and (C) cancer as the pathology. Applicants thank the Examiner for the telephonic discussion with Naomi Biswas on December 7, 2004, agreeing that Applicants may amend the claims and elect a total number of mutations allowed in the scaffold as being an integer between 1-20. Applicants have amended claim 3 to reflect this revised species in subspecies election (A).

Upon entry of this amendment, claims 1-10, 13-16 and 45-58 will be pending. Claims 11-12 are withdrawn pending the Examiners decision on Applicants' request to combine Groups I and II. Non-elected claims 17-44 have been cancelled. Claims 17-44 are canceled without

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prejudice or disclaimer as drawn to non-elected subject matter. Applicant reserves the right to pursue these claims in a later application. Claims 1, 3-6, 8 and 13-16 have been amended. Claims 45-58 have been added.

Support for amendments to claim 1 may be found *e.g.*, on pg 2 ln 31-32; pg 3 ln 3-6; and pg 44 ln 24-25. Support for amendments to claims 3-6 appears, *e.g.*, in claim 1 as filed and on pg 3 ln 7-9. Support for amendments to claim 8 appears, *e.g.*, on pg 2 ln 24-28. Support for amendments to claims 13-15 appears, *e.g.*, on pg 44 ln 24-25. Claims 3-6, 8 and 16 are amended to reformat or more distinctly claim the subject matter of the invention.

Support for new claims 45 and 57 is found, *e.g.*, on pg 32 ln 12-19. Support for new claim 46 is found, *e.g.*, on pg 21 ln 12-19. Support for new claim 47 is found, *e.g.*, on pg 44 ln 24-25. Support for new claims 48 and 58 is found, *e.g.*, on pg 4 ln 15-16. Support for new claims 49 and 55 is found, *e.g.*, on pg 9 ln 16-21. Support for new claims 50 and 54 is found, *e.g.*, on pg 45 ln 1-21. Support for new claim 51 is found, *e.g.*, on pg 3 ln 3-6. Support for new claims 52 and 56 is found, *e.g.*, on pg 40 ln 19-23. Support for new claim 53 is found, *e.g.*, in claims 1 and 16 as filed; on pg 2 ln 31-32; and on pg 3 ln 3-6. No new matter has been added.

### **CONCLUSION**

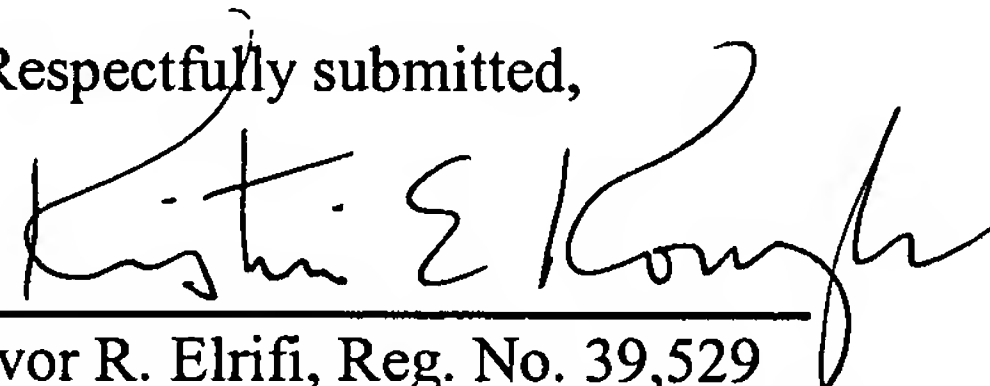
On the basis of the foregoing amendments and remarks, Applicants respectfully submit that this paper is fully responsive and that the pending claims are in condition for allowance. Such action is respectfully requested.

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This document is timely filed if submitted by Monday, January 3, 2005, with the enclosed petition for extension of time and fee. No additional charges are believed due. However, the Commissioner is hereby authorized to charge payment of any additional fees required in connection with the paper(s) transmitted herewith, or to credit any overpayment of same, to Deposit Account No. 50-0311, Reference No.25840-501. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Dated: January 3, 2005

Respectfully submitted,



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